

Appln No. 09/744,515

Amdt date May 11, 2004

Reply to Office action of November 13, 2003

### REMARKS/ARGUMENTS

Claims 1-32 are pending in the above-referenced matter.

Claims 1-13, 15, and 17-18 are amended and claims 19-32 are added to further define Applicant's invention.

This is a response to the Final Action dated November 13, 2003 and Advisory Actions of February 5, 2004 and April 5, 2004.

For the record, claims 2-13, 15, and 17-18 are identical to amended claims 2-12, 15, and 17-18 submitted in Applicant's response dated January 12, 2004 and March 15, 2004 but not entered by the Examiner.

Amended claims 1 and 13 are substantially similar to amended claims 1 and 13 submitted in Applicant's January 12th and March 15th responses with minor changes.

### §102(b) Rejection of Claim 1 by JP-9112636

In the Advisory Actions, the Examiner contends that on "lines 4-10 on pg. 10 of the English translation[,] there is a description of a means (or a hydraulic pump) for supplying fluid (pressurized oil) through an exterior of the hub 41 to a first face of the at least one piston 45F, 45B so as to move (or actuate) the at least one piston in a first direction." For completeness, the entire sentence containing the quoted passage is reproduced as follows:

*Part of the lubricating oil filling the automatic transmission case 8 is suctioned and pressurized by a hydraulic pump (not shown), and upon feeding it to either an oil chamber 46F between the partitioning wall 41a and the forward clutch on/off piston 45F or an oil chamber 46B between the partitioning wall 41a and the backward clutch on/off piston 45B through an oil passage provided inside the forward/reverse speed-changing shaft S3, the forward clutch on/off piston 45F or backward clutch on/off piston 45B is actuated. (JP-9112636, page 10, lines 3-10).*

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Thus JP-9112636 discloses a transmission device wherein the lubricating oil is pressurized by a hydraulic pump and delivers inside the oil chamber "through an oil passage provided inside the forward/reverse speed-changing shaft S3". Presumably, once inside the oil chamber, the lubricating oil then travels outwardly to activate or push a piston.

In the April 5, 2004 Advisory Action, the "Examiner interpreted elements inside the annulus of the hub such as piston 45F to be located in the interior portion of the hub and . . . [a]ny portions outside of the interior portion are considered as the exterior." Having taken the foregoing position, the Examiner made the following rejection on amended claim 1 submitted on March 15, 2004:

Consequently, shaft S3, for example, is exterior to the hub and the passage through which fluid is carried in the shaft is an exterior passage on an exterior of the hub. The passage piping into the chamber behind piston 45F is an interior passage. When the fluid flows from the passage in the shaft S3 to the member behind piston 45F, the flow is considered to be in a radially inward direction since the flow travels radially from an exterior of the hub to an interior of the hub. Accordingly, the rejections have been maintained.

Amended independent claim 1 recites a gearbox adaptor comprising a hub defining a longitudinal axis adapted to be engageable with a gear shaft for rotation therewith; at least one piston mounted within said hub; means for supplying fluid through at least one passage on an exterior of the hub to an interior passage in the hub adjacent the at least one piston in a radially inwardly flow direction towards the longitudinal axis of the hub to pressurize a first face of said at least one piston so as to move said at least one piston in a first direction; at least one gear locatable on said gear shaft adjacent said hub; at least one clutch means positioned between said at least one piston and a side wall of said at least one gear, part of said at least one clutch means being engaged with said hub and a different part of said clutch means being engageable with said at least one gear; wherein said at least one gear is freely rotatable relative to said shaft, and said

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at least one clutch means being located and arranged such that movement of said at least one piston in said first direction inter-engages said parts of said at least one clutch means to drivingly engage said at least one gear with said gear shaft.

Applicant submits that JP-9112636 does not anticipate claim 1 under §102(b) by disclosing each and every elements and limitations recited by claim 1. Among other things, Applicant submits that JP-9112636 discloses a means for supplying lubricating oil in a reverse and contrary fashion as the recited gearbox adaptor. Whereas in the claimed gear box adaptor, the flow passage is manipulated outside the casing and then flow inwardly towards the longitudinal axis of the hub, in the JP-9112636 reference, complicated passages are provided on a rotating shaft for supplying lubricating oil axially through an oil passage provided inside the speed-changing shaft and then radially outwardly once inside the oil chamber.

Even assuming the Examiner's tenuous position that the shaft S3 in JP-9112636 is exterior to the hub, although a section of which extends through the center of the hub and therefore cannot be exterior to the hub no matter how broadly the term "exterior" is construed, oil flows from the shaft S3 flows away from the longitudinal axis of the hub. Thus, JP-9112636 teaches away from the claimed gearbox adaptor. Accordingly, JP-9112636 cannot reject claim 1 by disclosing each and every elements and limitations recited by claim 1. Reconsideration and a notice of allowance are respectfully requested.

Because claims 2-9, 11, 12, 17, and 18 are also rejected under §102(b) by JP-9112636 and because they depend from claim 1, they too are allowable for the same reasons as claim 1. Notice and allowance thereof are respectfully requested.

**§103(a) Rejection of Claims 10 and 13-16 by JP-9112636 in view of Stieg or Patton et al.**

Claims 10 and 13-16 are dependent claims and depend, either directly or indirectly, from independent claim 1. Thus, even if JP-9112636 can be combined with Stieg or Patton et al., a point which Applicant does not concede, the combination does not render claim 1 obvious, and therefore does not render claims 10 and 13-16 obvious. Among other things, neither Stieg or

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Patton et al. discloses or teaches modifying the lubricating oil feed system disclosed by JP-9112636. Reconsideration and a notice of allowance are respectfully requested.

New Claims 19-32

New claims 19-32 include independent claims 19 and 26. No new matter is added by the new claims.

Applicant submits that independent claims 19 and 26 recite features that are novel in view of the primary reference JP-9112636. In other words, JP-9112636 does not anticipate the new claims by disclosing each and every element of the claimed gearbox.

In view of the foregoing remarks and amendments, the application is believed to be in condition for allowance and allowance is respectfully solicited.

Should the Examiner finds it necessary to speak with Applicant's attorney, she is invited to contact the undersigned at the telephone number indicated below.

Respectfully submitted,

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